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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

REAGAN, JAMES A

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 02/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/439,310	GLOOR ET AL.	
	Examiner	Art Unit	
	James A. Reagan	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 November 1999 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) 5-9 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 12 November 1999 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). 2
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) Other: _____

Detailed Action

1. This action is in response to the application filed on 12 November 1999.
2. Claims 1-9 are pending.
3. Claims 5-9 have been withdrawn from consideration.
4. Claims 1-4 have been examined.

Election/Restrictions

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a quality assurance method for services solutions, classified in class 705, subclass 7.
 - II. Claims 5-6, drawn to a method of managing quality assurance service solutions, classified in class 705, subclass 7.
 - III. Claims 7-9, drawn to a method of providing service solutions, classified in class 705, subclass 7.
6. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as performing a quality analysis on a defense contract.

See MPEP § 806.05(d).

Inventions III and I are related as subcombinations disclosed as usable together in a single combination. In the instant case, invention III has separate

utility such as appointing a contractor to provide a quality review for an Internet company. See MPEP § 806.05(d).

Inventions **II** and **III** are related as subcombinations disclosed as usable together in a single combination. In the instant case, invention **II** has separate utility such as managing a health care facility service. See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
8. During a telephone conversation with John Pivnichny on 15 February 2002 a provisional election was made **without** traverse to prosecute the invention of group **I**, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

9. The drawings have been objected to by the Draftsperson for the reasons stated on the PTO Form 948 attached hereto.

Specification

10. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

11. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
14. Claim 4 provides for the use of a first readiness review to determine whether communication, organization, tracking, change control, quality management, and reporting delivery plans are established, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. In the instant case, Examiner cannot determine which of the aforementioned plans are established, or which combination of plans will be established, or if any, some or all of the plans will be established. For the purposes of this Office action, Examiner will make a reasonable attempt to consider each plan categorically in the alternative, with the express

understanding that only one plan of the plurality listed will be considered as a limitation.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claim 4 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). In the instant case, the improper use of the Markush-type limitation regarding plans as described in paragraphs 13 and 14 above yields a process that is at the time of this consideration, non-statutory in that the application of the intended plan is not defined.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Eisener, "Essentials of Project and Systems Engineering Management", herein referred to as "Eisener."

Claim 1:

With regard to the limitation of *defining a first solution by a provider having a business objective, for a customer having a need*, Eisener discloses needs, goals and objectives as a statement of requirements to be supplied to a solutions provider (Chapter 3, The Project Plan, pages 46-53, and Chapter 7, The Thirty Elements of Systems Engineering, page 157). The provider, or systems engineering team, provides possible solutions to the customers needs in the form of Requirements Analysis and Allocation as well as Functional Analysis and Allocation, and later on an Architectural Design Synthesis based on the first round of solutions (Chapter 7, The Thirty Elements of Systems Engineering, page 158-160).

With regard to the limitation of *performing a first assurance review of said first solution to determine whether said first solution is technically viable, deliverable, and includes technical risk identification, assessment, and containment plans*, Eisener discloses an Alternatives Analysis and Evaluation, in which options and adjustments to the basic solution are entertained and appraised (Chapter 7, The Thirty Elements of Systems Engineering, page 160-161).

With regard to the limitation of *performing a second assurance review of said first solution to determine whether said first solution includes complete schedules, a complete cost and profit case, and said first solution satisfies both said provider business objectives and said customer need*, Eisener shows a Technical Peer Review (Item 10, Figure 7.3, page 155) and a feedback into the Reevaluation of Alternate Concepts step. Although not explicitly disclosed as part of a second assurance review, scheduling is disclosed as an important factor in project management as shown in section 3.5, Schedule (pages 58-60). In addition, cost and profits are also considered as an integral part of the project life cycle, as disclosed in section 7.3.8, Life-Cycle Costing (pages 163-165). Inherently, as disclosed above, all matters and concerns must fall within provider objectives and customer needs.

With regard to the limitation of *defining a second solution by said provider, by correcting any deficiencies identified in said first or second assurance reviews; thereafter, performing a first readiness review of said second solution to identify new issues or risks which arose during said obtaining customer commitment step, determine whether delivery plans are established, and establish baselines for performance and said profit case*, Eisener discloses Alternatives Analysis and Evaluation (section 7.3.6, pages 160-161) in which testing and evaluation are performed, quality assurance is reviewed and preplanned improvements are considered. Any new issues or risks are addressed during risk analysis. As shown in Figure 7.3, Items 6,7,8 (Alternatives) are inputted to a baseline concept

(Item 9), which goes through a Technical Peer Review (Item 10) and a Cost Analysis (Item 11) before the System Design Review (Item 14). This flow chart shows the inherently recursive nature of consistently searching for better solutions and testing and evaluation optional solutions before implementing them as the primary goal. Concurrent Engineering (section 7.3.10, pages 165-166) takes into account the possibility of improving and altering the engineering process throughout its life cycle to better achieve the goals of the plan and meet the needs of the customer.

With regard to the limitation of *periodically performing a project management review to verify said second solution is being managed as defined, meeting said profit case, and meeting said customer need; and thereafter, performing a deliverable readiness review to verify that said second solution has been delivered to said customer and that said second solution satisfies said customer need*, Eisener shows a Mission Design Review (Figure 7.2, Item 17) which is designed to ensure that each solution is on track and compliant with mission goals and objectives. In addition, the System Design Review (Figure 7.3, Item 14) ensures that the implementation of the solution is within technical specifications and guidelines, as derived from customer needs and defined metrics. Quality Assurance and Management (QA&M), as disclosed in section 7.3.20, pages 171-172, assures strict conformance with standards as dictated by the customer. Inherently, as shown above, each review is underpinned with the assumption that the customers needs must be met accordingly.

Claim 2:

With regard to the limitation of *performing a third assurance review of said second solution to determine whether said deficiencies have been satisfactorily corrected*, Eisener shows three reviews during the engineering process (Figure 7.3, Items 5, 10, and 14). Although Eisener does not specifically disclose that a third review is intended determine whether said deficiencies have been satisfactorily corrected, it is the inherent nature of any reviewing process to uncover flaws, liabilities, or errors during the design phase before the implementation and delivery phases of a product or service, as discussed in the rejection of Claim 1 above.

Claim 3:

With regard to the limitation of *obtaining customer commitment to said second solution*, Eisener discloses providing an explanation to the customer regard an alternative solution before implementing an alternative plan (Section 7.3.6, pages 160-161). Inherently, as part of any systems engineering process, the customer is the final authority and makes the decision whether to implement a strategy or plan, and should be consulted before significant modifications are consummated.

Claim 4:

With regard to the limitation of *determining whether communication, organization, tracking, change control, quality management, and reporting delivery plans are established*, Eisener discloses Training and Documentation i.e.

communication (Section 7.3.25, page 174; Section 7.3.24, page 174); Systems Engineering Management i.e. organization (Section 7.3.30, pages 175-176); Operations and maintenance (O&M) i.e. tracking (Section 7.3.28, page 175); Preplanned Product Improvement (P3I) i.e. change control (Section 7.3.23, pages 173-174); Quality Assurance and Management (QA&M) (Section 7.3.20, pages 171-172); and Installation i.e. delivery (Sections 7.3.27 and 7.3.30, pages 175-176).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - (a) US 6,161,113 (Mora et al.). Mora discloses a project notebook designed for a project development team with associated software and methodology.
 - (b) US 5,208,765 (Turnbull). Turnbull discloses a method and structure for monitoring product development.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Reagan whose telephone number is 703.306.9131. The examiner can normally be reached on 8:00a - 5:00p M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703.305.9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703.746.7239 for regular communications and 703.746.7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

JAR
February 17, 2002



KYLE J. CHOI
PRIMARY EXAMINER
Art Unit 2163